

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of:

NOBUYUKI NONAKA

Group Art Unit: 3714

Serial No.: 10/697,237

Examiner: Robert E. Mosser

Filed: October 31, 2003

Confirmation No.: 9024

Docket No.: 247079-000781USPT

Customer No.: 70243

For: **GAMING MACHINE**

REPLY BRIEF UNDER 37 C.F.R. § 41.41

MAIL STOP APPEAL BRIEF – PATENTS (VIA - EFS)

COMMISSIONER FOR PATENTS

United States Patent and Trademark Office

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Commissioner:

In response to the final rejection of claims set forth in the Office Action mailed on May 24, 2010, a Notice of Appeal was filed on November 16, 2010, pursuant to 37 C.F.R. § 41.31. In support of the Notice of Appeal, an Appeal Brief was concurrently filed on November 16, 2010, pursuant to 35 U.S.C. § 134(a) and 37 C.F.R. §§ 41.37. An Examiner's Answer was subsequently issued on March 1, 2011. Responsively, Appellant now submits the following Reply Brief pursuant to 37 C.F.R. § 41.41. Pursuant to 37 C.F.R. § 41.41(a)(I), the Reply Brief was to be filed within two months from the issuance of the Examiner's Answer, i.e., by May 1, 2011. This deadline expired on a Sunday; this paper is being submitted on the next succeeding business day, and is therefore timely. Accord 37 C.F.R. §1.7; MPEP 710.05.

To the extent necessary, please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Nixon Peabody, Deposit Account No. 50-4181, Order No. 247079-000781USPT. Please credit any additional fees or overpayments to the same Deposit Account.

I. STATUS OF CLAIMS

Claims 8, 9, 11-13, 15, 16 and 18 are pending in this application. Claims 1-7, 10, 14 and 17 were previously cancelled, without prejudice or disclaimer. No claims have been allowed by the Examiner. Claims 8, 9, 11-13, 15, 16 and 18 have each been rejected two or more times, and are therefore the subject of this appeal.

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether claims 8, 9, 11-13 and 18 are unpatentable under 35 U.S.C. § 103(a) as being obvious over U.S. Patent Appl. Publ. No. 2005/0192090 A1, to Muir et al. (hereinafter “Muir”), in view of U.S. Patent No. 6,517,433 B2, to Loose et al. (hereinafter “Loose”), and U.S. Patent No. 6,507,385 B1, to Nishiyama et al. (hereinafter “Nishiyama”).

2. Whether claims 15 and 16 are unpatentable under 35 U.S.C. § 103(a) as being obvious over Muir in view of Loose and Nishiyama, and further in view of U.S. Patent No. 4,573,681, to Okada (hereinafter “Okada”).

III. ARGUMENTS

A. THE PENDING REJECTION OF CLAIMS 11 AND 18 DOES NOT CLEARLY ARTICULATE THE GROUNDS FOR REJECTION IN VIOLATION OF FEDERAL STATUTE, JUDICIAL STANDARDS, AND MANUAL OF PATENT EXAMINING PROCEDURE (MPEP) DIRECTIVES.

The pending rejection of independent claims 11 and 18 wholly fails to clearly articulate how claimed inventions “as a whole” are obvious, denying Appellant an opportunity to fully respond to and refute the rejection.

The Code of Federal Regulations explicitly requires that “[t]he reasons for any adverse action or any objection or requirement [] be stated in an Office Action”. 37 C.F.R. § 1.104(a)(2). *See, also*, 37 C.F.R. §§ 1.104(b) (“The examiner’s action will be complete as to all matters.”); 1.104(c)(2); MPEP 706; 2141. “It is essential that patent applicants obtain a prompt yet complete examination of their applications.” MPEP 2106. It is therefore axiomatic, according to the MPEP, that:

USPTO personnel [] state all reasons and bases for rejecting claims in the [] Office action. **Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection.** ... A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.

* * *

[E]very limitation in the claim must be considered. USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. **Instead, the claim as a whole must be considered.**

* * *

The burden is on the USPTO to set forth a *prima facie* case of unpatentability. Therefore if USPTO personnel determine that it is more likely than not that the claimed subject matter [violates] statutory [requirements], **they must provide an explanation.**

Id., (italicized emphasis in original; bold emphasis added). Of paramount importance, MPEP directives require an examiner to “clearly articulate any rejection ... so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely”. MPEP 706.

In an obviousness rejection, **the reviewing examiner must provide a clear articulation, on the record, where each element and limitation of the rejected claim can be found in the prior art.** *See* KSR Int’l Co., 127 S. Ct. at 1741. *See also*, MPEP 2143 (“The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.”) In determining the differences between the prior art and the claims, *see Graham v. John Deere Co.*, 383 U.S. 1 (1966), the question under § 103(a) “is not whether the differences themselves would have been obvious, but whether **the claimed invention as a whole would have been obvious.**” MPEP 2141.02, citing *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (Fed. Cir. 1983) (emphasis added). “[W]hen the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference.” *In re Rijckaert*, 9 F.3d 1531, 1533 (Fed. Cir. 1993).

Failure to present a complete rejection, including addressing each and every claim limitation (i.e., the claimed invention as a whole), is proper grounds for reversing the claim rejection. In *Ex parte Schricker*, for example, the Board of Patent Appeals and Interferences vacated all pending rejections, finding that “[t]he examiner has left applicant and the board to guess as to the basis of the rejection and after having us guess would have us figure out (i.e., further guess) what part of which [prior art] document supports the rejection”. 56 USPQ2d 1723

(B.P.A.I. 2000) (emphasis added). Moreover, as recently demonstrated by the U.S. Court of Appeals for the Federal Circuit, in *In re Buszard*, the failure to properly articulate a rejection, through evidence and argument on the record, denying an applicant an opportunity to refute the rejection is grounds for reversal of a claim rejection. 84 USPQ2d 1749, 1751 (Fed. Cir. 2007).

The pending § 103(a) rejections do not address each and every limitation of independent claims 11 and 18 (i.e., the claimed inventions as a whole), nor do these rejections clearly indicate where each and every limitation of claims 11 and 18 can be found in the prior art, denying Appellant an opportunity to fully respond to and refute the rejections. In particular, both the Final Office Action mailed on May 24, 2010 (hereinafter “Final Action”), as well as the Examiner’s Answer mailed on March 1, 2011 (hereinafter “Examiner’s Answer”), collectively reject independent claims 8, 11 and 13 as if a single claim. That is, a close review of the rejections set forth on pages 4-6 of the Examiner’s Answer and pages 2-4 of the Final Office Action (which appear to be identical) reveals that the Examiner rejects all three of these independent claims based solely on an analysis of the limitations of independent claim 8. However, the limitations presented in independent claims 11 and 18 are not identical to those set forth in independent claim 8. By way of example, claim 11 recites “[determining] a degree of shielding” or “[controlling] the shielding state of the display shielding unit of the liquid crystal shutter display device in accordance with the degree of the shielding of the display of the symbols”. Neither the Final Action nor the Examiner’s Answer addresses either of these limitations.

These omissions leave Appellant to guess as to the basis of the rejection of claims 11 and 18, and further guess what part of which reference or references are being relied upon or in fact support such a rejection. Moreover, by failing to provide a clear articulation of the reasons why the inventions claimed in 11 and 18 would have been obvious, the Examiner denied Appellant an opportunity to refute the rejection. Accordingly, the pending § 103(a) rejection of claims 11 and 18 violates the law of obviousness, including statutory provisions, MPEP directives, and judicial precedent, and should therefore be reversed, such action being herein respectfully requested.

Appellant respectfully solicits this Honorable Board to reverse, or at least remand, the § 103(a) rejection of claims 11 and 18 for at least the foregoing reasons.

B. THE APPLIED REFERENCES HAVE NOT BEEN SHOWN TO DISCLOSE EACH AND EVERY LIMITATION OF CLAIM 8.

The Muir, Loose and Nishiyama references have not been shown to teach or suggest, singly or in aggregate, each and every limitation of claim 8. Claim 8 recites, *inter alia*:

[controlling] the display shielding unit of the liquid crystal shutter display device to enter the shielding state so as to prevent the transparent display region of the liquid crystal display device from transparently displaying the plurality of symbols arranged on the display device ... where arrangement of a predetermined symbol combination on the display device is determined as a result of the process

In rejecting claim 8, the Examiner concedes that Muir “does not tie the use of the of the [sic] shutter mechanism to the reel outcome.” Examiner’s Answer, at 5, ¶ 1. *See, also*, Final Action, at 3, ¶ 7. Nishiyama, which is cited for reasons other than the foregoing limitation, *see, e.g.*, Examiner’s Answer, at 5-6, likewise fails to teach or suggest tying the use of an LCD shutter mechanism to a reel outcome of a wagering game. In light of this omission, the Examiner turns to the Loose reference, finding that:

Loose teaches the use of a reel game with various randomly selected (alternatively described by appellant as la ottery [sic]) outcomes wherein based on the occurrence of a predetermined outcome a overlaid liquid crystal display is activate and in addition thereto Loose further teaches that an extendable opaque shade may be used during the bonus game to enable clear viewing of the liquid crystal display device (Loose Col 3:27-4:3; 4:28-57; 5:24-51).

Id. Loose has not been properly shown to disclose the foregoing limitation, rendering the corresponding § 103(a) rejection improper and erroneous.

Loose has not been properly shown to disclose “a liquid crystal shutter display device disposed between the display device and the liquid crystal display device,” or “[controlling] ... the liquid crystal shutter display device to enter the shielding state so as to prevent the transparent display region of the liquid crystal display device from transparently displaying the plurality of symbols ... where arrangement of a predetermined symbol combination on the display device is determined,” as set forth in claim 8. For instance, conducting a key term search in Loose reveals zero results for “liquid crystal shutter,” or even just “shutter,” which in turn indicates that Loose does not explicitly teach the shutter, as claimed, let alone varying the operational state of a separate liquid crystal shutter based on the outcome of

a slot game. As such, a *prima facie* case of obviousness has not been made considering the applied references have not been shown to disclose each and every limitation of claim 8. Based on this deficiency alone, or in conjunction with the omissions and deficiencies previously highlighted in Appellant's Appeal Brief, the rejections of claim 8 and any claims depending therefrom are improper and should therefore be reversed.

Appellant respectfully requests this Honorable Board reverse the pending § 103(a) rejections of claims 8 and 9 for at least the foregoing reasons and the reasons set forth in Appellants' Appeal Brief.

C. THE APPLIED REFERENCES HAVE NOT BEEN SHOWN TO DISCLOSE EACH AND EVERY LIMITATION OF CLAIM 11.

The Muir, Loose and Nishiyama references have not been shown to teach or suggest, singly or in aggregate, each and every limitation of independent claim 11. Claim 11 recites, *inter alia*, a controller that is configured to:

- (a) determine the plurality of symbols arranged on the display device;
- (b) **determine a degree of shielding** of display of the symbols arranged on the display device ... **[when] arrangement of a predetermined symbol combination on the display device is determined** as a result of the process (a);
- (c) **control the shielding state of the display shielding unit of the liquid crystal shutter display device, in accordance with the degree of the shielding** ... [as] determined in the process (b);

(Emphasis added.) As noted above, the Examiner rejects independent claim 11 based on the elements and limitations set forth in claim 8. Consequently, a *prima facie* case of obviousness has heretofore not been made against claim 11, which is grounds in and of itself for reversal of the pending § 103(a) rejection thereof.

Irrespective of the substantive omissions of the Final Action and the Examiner's Answer, the applied references – i.e., Muir, Loose and Nishiyama, do not in fact teach, suggest or otherwise disclose all of the limitations highlighted above. That is, none of the cited references explicitly or implicitly discloses determining the arrangement of displayed symbols, determining a degree of shielding based on the determined arrangement of displayed symbols, **and controlling the operational state of a liquid crystal shutter display in accord with the**

determined degree of shielding based associated with the arrangement of displayed symbols. Muir does disclose that varying the energy levels applied to the zones 78 of the shutter mechanism 76 presented in reference FIG. 8 allows for varying the degrees of transparency of those zones 78. Nonetheless, Muir does not teach or suggest “determin[ing] a degree of shielding” based on the “arrangement of a predetermined symbol combination on the display device,” or varying “the shielding state of the display shielding unit of the liquid crystal shutter display device” according to the determined degree of shielding. Based on this deficiency alone, or in conjunction with the omissions and deficiencies previously highlighted in Appellant’s Appeal Brief, the rejections of claim 11 and any claims depending therefrom are improper and should therefore be reversed.

Appellant respectfully solicits this Honorable Board to reverse the pending § 103(a) rejections of claims 11-13 for at least the foregoing reasons and the reasons set forth in Appellants’ Appeal Brief.

D. THE APPLIED REFERENCES HAVE NOT BEEN SHOWN TO DISCLOSE EACH AND EVERY LIMITATION OF CLAIM 15.

Muir, Loose, Nishiyama and Okada have not been shown to disclose, teach or suggest, singly or in aggregate, each and every limitation of independent claim 15. Claim 15 recites, *inter alia*:

a liquid crystal display device ... including **a plurality of transparent display regions** for transparently displaying the symbols arranged on the display device;

a liquid crystal shutter display device ... [with] **a plurality of display shielding units provided at positions corresponding to the transparent display regions of the liquid crystal display device**, the display shielding units being controlled to enter a shielding state ... to shield display of the symbols arranged on the display device ...;

a controller ... configured to [] control a respective one of the display shielding units of the liquid crystal display device to enter the shielding state[] so as to:

sequentially arrange the plurality of symbols in the plurality of columns on the display device[] in accordance with a predetermined order stored in a memory, and

shield the display of the symbols being arranged on the display device[] in accordance with the predetermined order stored in the memory ... where arrangement of a predetermined symbol combination on the display device is determined as a result of the process (a)

(Emphasis added.) None of the cited references, whether considered alone or in combination, teach or suggest all of the above-highlighted limitations.

Similar to the rejection of independent claims 11 and 18, the Examiner bases the § 103(a) rejection of claim 15, at least in part, on the analysis of the limitations in independent claim 8. *See* Examiner's Answer, at 6, ¶ 3. In so doing, the Examiner once again fails to address numerous limitations set forth in independent claim 15 (i.e., the claimed invention as a whole), and further fails to indicate where these limitation can be found in the prior art. For example, the Examiner does not address or indicate where in the prior art is disclosed Appellant's claimed LCD device that includes **"a plurality of transparent display regions"** through which the symbols arranged on the display device are transparently displayed. (Emphasis added.) In this vein, the Examiner also fails to address or indicate where in the prior art is disclosed Appellant's claimed liquid crystal shutter with **"a plurality of display shielding units provided at positions corresponding to the transparent display regions of the liquid crystal display device"**. (Emphasis added.) In yet another instance, the Examiner does not speak to or indicate where in the prior art is disclosed a controller controlling a liquid crystal shutter display to **"shield the display of the symbols being arranged on the display device[] in accordance with the predetermined order stored in the memory"**. (Emphasis added.) Consequently, a *prima facie* case of obviousness has heretofore not been made against claim 15, which is grounds in and of itself for reversal of the pending § 103(a) rejection thereof.

Notwithstanding the substantive omissions of the Final Action and the Examiner's Answer, the applied references do not in fact teach, suggest or otherwise disclose each and every limitation of claim 18. For instance, neither Muir, Loose, Nishiyama nor Okada has been shown to disclose an LCD device with a plurality of transparent display regions. In contrast, Muir discloses a multi-layered flat-panel LCD 50 with an LCD monitor 68 having a superimposed touchscreen 70. *See* Muir, ¶¶ [0048], [0058]. Muir indicates that the LCD 50 is at least partially transparent so that images or symbols carried on the reels 18 of the symbol carrying arrangement 16 are visible through the LCD 50. *See, id.*, ¶ [0049]. Muir, however, never indicates that the LCD 50 or the LCD monitor 68 has **"a plurality of transparent display regions"** through which the displayed symbols may be viewed, as required by claim 15. In this regard, Muir does not indicate that the zones 78 of the shutter mechanism 76 in FIG. 8 "[are]

provided at positions corresponding to the transparent display regions of the liquid crystal display device,” which is also required by claim 15. Based on these deficiencies alone, or in conjunction with the omissions and deficiencies highlighted above or previously presented in Appellant’s Appeal Brief, the rejections of claim 15 and any claims depending therefrom are improper and should therefore be reversed.

In addition to the foregoing omissions, Muir, Loose, Nishiyama and Okada also fail to teach or suggest a liquid crystal shutter display with a plurality of shielding units that are controlled to “shield the display of the symbols being arranged on the display device[] in accordance with the predetermined order stored in the memory”. As previously noted, this limitation is not addressed in the Final Action or the Examiner’s Answer. Rather, in rejecting independent claim 15, the Examiner focuses solely on the time based sequential modification of the display device (which is a different claim element from the liquid crystal shutter display and corresponding display shielding units). At no point do any of the applied references touch on sequentially arranging the symbols on the display device in accordance with a predetermined order stored, and shielding these sequentially arranged symbols with the liquid crystal shutter “in accordance with the predetermined order stored in the memory”. Based on this deficiency alone, or in conjunction with the numerous omissions and deficiencies highlighted above or previously presented in Appellant’s Appeal Brief, the rejections of claim 15 and any claims depending therefrom are improper and should therefore be reversed.

Appellant respectfully solicits this Honorable Board to reverse the pending § 103(a) rejections of claims 15 and 16 for at least the foregoing reasons and the reasons set forth in Appellants’ Appeal Brief.

E. DEPENDENT CLAIM 12 IS ALLOWABLE REGARDLESS OF THE PATENTABILITY OF INDEPENDENT CLAIM 11

Claim 12 is patentable over the Muir, Loose and Nishiyama references irrespective of the patentability of base claim 11. Claim 12 requires the controller be further configured to:

determine, in the process (b), the degree of the shielding of the display of the symbols arranged on the display device and transparently displayed on the transparent display

region of the liquid crystal display device, in accordance with type of the predetermined symbol combination determined in the process (a), in a case where arrangement of the predetermined symbol combination on the display device is determined as a result of the process (a).

Once again, similar to the rejection of independent claims 11 and 18, the Examiner bases the § 103(a) rejection of claim 12 in its entirety on the analysis of the limitations in independent claim 8. Consequently, the claimed invention as a whole is never properly addressed in the Final Action or the Examiner's Answer. In addition, or as an alternative ground for reversing the rejection of claim 12, the applied references do not teach each and every limitation set forth in claim 12.

For at least the foregoing reasons, Appellant respectfully requests this Honorable Board to reverse the pending § 103(a) rejection of claim 12.

IV. SUMMARY

Appellant respectfully solicits the Honorable Board to reverse the Examiner's 35 U.S.C. § 103(a) rejections of claims 8, 9, 11-13, 15, 16 and 18 at least upon the grounds presented above, the grounds presented in Appellant's Appeal Brief, or both.

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It is believed that no fees are due in connection with the filing of this Reply Brief. However, should any fees be deemed necessary, the Commissioner is hereby authorized to charge Nixon Peabody Deposit Account No. 50-4181, Order No. 247079-000781USPT, for any fees that may be inadvertently omitted which may be necessary now or during the pendency of this application, except for payment of the issue fee. Please credit any additional fees and overpayments to the same deposit account.

Respectfully submitted,

Date: May 2, 2011

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